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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/827,380

04/04/2001

Carl-Eric Ohlson

1166/61926-A

7391

23432

7590

11/29/2002

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EXAMINER

DUNN, DREW A

ART UNIT

PAPER NUMBER

2882

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,380

Applicant(s)

Ohlson

Examiner

Drew A. Dunn

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4 Apr 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/776,392.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 & 5 6) ☐ Other: _____



Paper No. 6

Application Number: 09/827,380

Filing Date: 04/04/01

Applicant(s): Ohlson

DETAILED ACTION

Reissue Applications

I. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

II. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. (u)

Specifically, applicant has relied upon the error stated in the oath/declaration which is the same as the error relied upon in the parent reissue application and therefore does not meet the requirement of stating a new and different error with regards to the defectiveness of the patent.

III. Claims 20-22 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

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The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

IV. *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "under-table tube," "over-table tube" and an "X-ray source movable in an x-direction and y-direction and z-direction and rotatable about a horizontal axis" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. **NB!** Applicant is advised, however, that the subject matter of an "under-table tube" is objected *infra* as being "new matter."

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

V. *Specification*

Minor Objection

The disclosure is objected to because of the following informalities: in column 5, lines 1-2, the statement that the source is not shown is incorrect in light of the amended figure 20.

Appropriate correction is required.

New Matter Objection

The amendment filed 04/04/01, when filing the application, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material

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which is not supported by the original disclosure is as follows: there is no support for an "under-table tube" as claimed by applicant in light of one of ordinary skill in the art's understanding of an "under-table tube."

Applicant is required to cancel the new matter in the reply to this Office Action.

VI. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for an "under-table tube" as claimed by applicant in light of one of ordinary skill in the art's understanding of an "under-table tube."

VII. *Claim Rejections - 35 U.S.C. § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, applicant argues that the illustration in figure 17 provides support for the claimed limitations of an "under-table tube capable of imaging in a style of under-table tube."

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This support is not correct. Rather, the support found with regards to figure 17, and any associated disclosure, is drawn towards a "below the plane of the table tube for imaging below the plane of the table." This is further apparent in the disclosure of imaging a patient's knees. (See column 7, lines 30+). In other words, the support found in applicant's disclosure fails to support, and is actually repugnant to the accepted definition of an "under-table tube" style as is known in the art. Lastly, as stated *supra*, in column 5, lines 1-2, applicant's specification discloses that the source is not shown. Therefore, the amended figure 20 only has generic support for illustrating the positioning of the source to image a patient's knees.

VIII.***Allowable Subject Matter***

Claim 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and the rejection based on a defective, set forth *supra* in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: though the prior art discloses solid state imaging systems for X-ray diagnostics and further including systems wherein an X-ray source is capable of being positioned above a patient and being movable in the x, y and z Cartesian coordinates and being rotatable, it fails to teach or fairly suggest a holding mechanism configured to hold a radiation receptor for electronic image storage comprising a filmless system such that the radiation receptor is horizontally movable, pivotable on a horizontal axis which crosses the vertical axis and rotatable about an axis which crosses the horizontal axis and is parallel to the detecting plane of the radiation receptor wherein the X-ray beam source comprises an X-ray beam source for selectively imaging a patient from

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above the table when the patient is lying down on the table and from below the plane of the table when the radiation receptor is below the table.

IX. *Information Disclosure Statement*

"Part" of the information disclosure statement filed September 24, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because several of the references are not dated. Therefore, only the U.S. Patent references and Foreign Patent have been considered whereas the remainder of the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 C(1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Pat. No. 4,894,855 to Kresse discloses an X-ray imaging system with two articulated arms; one supporting an X-ray source and the other supporting an X-ray image intensifier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Drew A. Dunn*** whose telephone number is (703) 305-0024. The examiner can normally be reached between the hours of 8:00 AM to 3:00 PM Monday thru Thursday and every other Friday (second Friday of the bi-week).

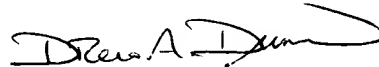
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim, can be reached on (703) 305-3492. The fax phone number for this Group is (703) 308-7722 or (703)308-7724.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [drew.dunn@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Drew A. Dunn
Primary Examiner Art Unit 2882
20 November 2002